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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/810,184 | 03/29/2004 | Lynn A. Buckner | | 7977 |

7590
LYNN A. BUCKNER
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Chickamauga, GA 30707

10/31/2007

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| EXAMINER |
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BEACH, THOMAS A

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| ART UNIT | PAPER NUMBER |
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3671

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10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,184

Applicant(s)

BUCKNER, LYNN A.

Examiner

Thomas A. Beach

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 18-22, 24-34 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 23 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly amend claims 16, 18-22, 24-34 and 36 (newly submitted) are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 17, 23 and 35 constitute Invention I, the combination of an mobile vacuum method including excavation and the claims 16, 18-22, 24-34 and 36 are directed to a different, independent Invention II comprising a compact mobile vacuum method, such a as household vacuum cleaner. Since Invention I requires excavating using a vacuum method, class 37; it is distinct from the now amended claims that do not require mud recovery or excavation, thus having a different classification, class 15.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Invention II, claims 16, 18-22, 24-34 and 36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17, 23 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preambles of these dependent claims still have improper antecedent basis. "A vacuum method" is improper - *for example* claim 19 should read "The compact mobile vacuum method according to claim 16, ". All dependent claims should begin with "The...method according to claim..."

The method claims 16-25 still fail to have proper method steps - *for example* the phrases "having a means..." or "means having" do not constitute a method step.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilman 6,470,605. Gilman shows a mobile surface cleaning or excavating vacuum method comprising a compact arrangement means to minimize the surface foot print (relative claim language in which the chassis wheels are considered "a small footprint") and to concentrate the weight of a system, said mobile vacuum arrangement means having a vacuum container C, and a liquid storage container W, said vacuum container being mounted at an inclined slope sufficient to allow solids and liquids to empty from said vacuum container by gravity (fig 2) and to provide space for said liquid storage

container to be mounted below said incline of said vacuum container and further comprising the steps of having a means of mounting a filter housing 48 adjacent to said vacuum container so as to allow a single door access to both said filter housing and said vacuum container, and providing a means of producing a vacuum within said vacuum container and said filter housing having connecting conduits to flow air from said vacuum container through said filter housing to said vacuum producing means, and said filter housing having filters disposed within it to remove solids from said air.

As concerns claim 35, Gilman the steps of: providing a mobility means chosen from the group consisting of mounting said vacuum method on a powered zero-turn radius vehicle, a powered track mobile vehicle, a track hoe, a back hoe, a trailer, a skid mount, an attachment for a skid steer, an attachment for a fork lift, a truck mounted unit, and a rail road car mounted unit (fig 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Pobihuschcy 5,408,766. As concerns claim 23, Gilman shows a vacuum method comprising the steps of having a means to open or close, said vacuum debris container access door but does not show using a telescoping means disposed within said vacuum

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debris container, said telescoping means being one or more devices selected from the group consisting of a hydraulic cylinder, air cylinder and a linear actuator. However, Pobihuschcy shows a similar vacuum method for excavating having a door 20 in the debris container 12 that is hydraulically operated (col. 2, lines 55+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify, as taught by Pobihuschcy, to include a hydraulically operated to provide power means to operably open and close the door without manual strength required, thus improving safety.

Response to Arguments

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Thomas A. Beach

October 28, 2007

THOMAS A. BEACH
Primary Examiner
Group 3600